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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,595	10/04/2000	Ernest S.Y. Wong	391442004300	8464

25225 7590 06/07/2002
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EXAMINER

LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,595

Applicant(s)

Wong et al.

Examiner

Hong Liu

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-7 and 14-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-7 and 14-20 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) ☐ Other: _____

Art Unit: 1624

DETAILED ACTION

Claims 1, 3-7, and 14-20 are pending in this application.

This action is in response to the applicants' amendment and reply filed on April 29, 2002.

Response to Arguments

Applicants' arguments filed on April 29, 2002 have been fully considered but they are not persuasive. Rejection to Claims under 35 U.S.C. 102, 103(a) is maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The rejections to claims under 35 U.S.C. 112, first and second paragraph are hereby withdrawn. Applicants have amended the claims to overcome the rejection.

Claim Rejections - 35 USC § 102

Claims 1, 3-7, 14-16 and 18-20 remain rejected under 35 U.S.C. 102(b) as being anticipated by Skov et al. (US Patent 4,921,963). The compounds made in the reference also contain alkyl-substituted imidazole besides the prerequisite of the nitro substitution. See examples in column 6.

All other 102 rejections are hereby withdrawn in view of applicants' amendment.

Art Unit: 1624

Claim Rejections - 35 USC § 103

Claims 1, 3-7, 14-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Skov et al. (US 4,921,963). Applicants' arguments have been considered but are not found persuasive. Applicants argue that there is no motivation in the reference to suggest other substituents, in particular, alkyl group on the heterocyclic amine moiety except for the nitro group. The reference actually shows imidazole substituted by both nitro and an alkyl group. In addition, applicants' amended claims state that the heterocyclic amine has at least one alkyl substituent, which could be interpreted to mean that there could be other substituents such as a nitro group as long as there is an alkyl group substitution. Thus, the instantly claimed compounds are still generically embraced by the reference.

Claims 1, 3-7 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murrer et al. (US 5,665,771). It is true that the heterocyclic amine shown in the example is pyridine which does not overlap with the four heterocyclic amines claimed in the present invention. However, the reference teaches the equivalence of pyridine and other 5- or 6-membered heterocyclic amines. See col.1, line 39-42. Moreover, the pyridine rings in the example are all substituted with an alkyl group. Given such teaching of the reference, one ordinary skilled in the art would be motivated to modify the compounds to arrive at the instant invention.

Conclusion


1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1624

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
June 2, 2002


Mukund Shah
Supervisory Patent Examiner
Art Unit 1624